Remarks/Arguments

Claims 10-29 are pending in this application, and are rejected in the Office Action of June 9, 2008. No claim amendments are presented in this response. However, a listing of the pending claims in this application is included with this response for the Examiner's convenience.

Re: Claims 10-29

Claims 10-29 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,374,406 issued to Hirata (hereinafter, "Hirata") in view of WO 99/35847 (hereinafter, "Westlake"), and further in view of U.S. Patent No. 5,375,235 issued to Berry et al. (hereinafter, "Berry"). Applicants respectfully traverse this rejection for at least the following reasons.

Applicants first note that independent claim 10 recites:

> "receiving an electronic mail message remotely from a user, said electronic mail message comprising an operating command and program identification information including at least one of a first type of program identification information and a second type of program identification information;
>
> processing said electronic mail message to determine whether said electronic mail message includes said first type of program identification information;
>
> scheduling an event responsive to said operating command for a program identified by said program identification information without searching program guide information for said program if said electronic mail message includes said first type of program identification information;
>
> continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information ***only if said electronic mail message does not include said first type of program identification information***;
>
> searching said program guide information for said program using said program identification information ***only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information***; and
>
> scheduling said event responsive to said operating command if said program is found during said searching step." (emphasis added)

As indicated above, independent claim 10 defines a method for scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message that includes an operating command and at least one of two different types of program identification information (e.g., channel/time information and/or a program name). The received electronic mail message is processed to determine whether it includes the first type of program identification information. An event is scheduled responsive to the operating command for a program identified by the program identification information without searching program guide information for the program if the electronic mail message includes the first type of program identification information.

Also according to the method, the electronic mail message continues to be processed to determine whether it includes the second type of program identification information only if the electronic mail message does not include the first type of program identification information. The program guide information is then searched for the program using the program identification information only if the electronic mail message includes the second type of program identification information and does not include the first type of program identification information. An event is scheduled responsive to the operating command if the program is found during the search of the program guide information. Independent claims 17 and 24 define similar subject matter in apparatus format. In the aforementioned manner, the claimed invention defines a method and apparatus for scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message that advantageously provides enhanced performance and versatility by being able to schedule the event in response to at least two different types of program identification information (e.g., channel/time information and/or a program name).

Applicants submit that neither Hirata, Westlake nor Berry, whether taken individually or in combination, teaches or suggests all of the foregoing elements of independent claims 10, 17 and 24. On page 4 of the Office Action dated June 9, 2008, the Examiner admits:

> "Hirata fails to disclose continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information, searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information, and scheduling said event if said program is found during said searching step." (emphasis added)

As indicated above, the Examiner admits that the primary reference Hirata fails to disclose, *inter alia*, the claimed "continuing to process….", "searching said program guide information…." and "scheduling said event …" elements of independent claims 10, 17 and 24. The Examiner attempts to remedy part of this deficiency of Hirata by relying on Westlake. In particular, the Examiner ostensibly alleges that Westlake teaches the claimed "searching said program guide information … " element of independent claims 10, 17 and 24 (see page 4 of the Office Action dated June 9, 2008). Applicants respectfully disagree and submit that Westlake does not teach or suggest, *inter alia*, the claimed "searching said program guide information…." element as defined by independent claims 10, 17 and 24.

Westlake teaches a method that includes steps of receiving an electronic message and comparing terms in the received electronic message to terms in the program information of an electronic program guide (EPG) (see, for example, page 23, lines 14-28 and steps S1-S2 of FIG. 3). The Examiner alleges that these steps of Westlake correspond to:

> "… determining if a received electronic mail message includes a second type of program identification information and searching program guide information for an identified program using said program identification information" (see page 4 of the Office Action dated June 9, 2008).

In response, Applicants note that the aforementioned comparison step of Westlake is ostensibly performed for all terms included in the received electronic message and without regard to whether certain information is included or not included in the received electronic message. As such, Westlake does not teach or suggest, *inter*

alia, the conditional language included in the step of "searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and ***does not include*** said first type of program identification information" (emphasis added) because Westlake never determines if the electronic message "does not include said first type of program identification information" as claimed. Accordingly, the proposed combination of Hirata and Westlake fails to teach or suggest, *inter alia*, the claimed step of: "searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information" (see, for example, claim 10).

On page 5 of the Office Action dated June 9, 2008, the Examiner further admits that:

> "Hirata and Westlake fail to disclose continuing to process the electronic mail message only if the first type of program identification information is not included."

As indicated above, the Examiner admits that the proposed combination of Hirata and Westlake fails to disclose, *inter alia*, the claimed "continuing to process…." element of independent claims 10, 17 and 24. The Examiner attempts to remedy this deficiency of the Hirata/Westlake combination by relying on Berry. In particular, on pages 5-6 of the Office Action dated June 9, 2008, the Examiner alleges:

> "In an analogous art, Berry teaches performing a searching operation, where a search is first performed on a first type of information, and only broadens the search for a second type of information if a match is not found in the first search, providing the benefit of improved speed by avoiding unnecessary searching (wherein a first type of words are highly specific and are located quickly, whereas a second type of words are less specific and require more processor intensive searching, therefore the type 1 words are given priority, and additional searching is done if a type 1 word is not found." (citing column 4, lines 3-9 and column 5, line 36 to column 6, line 19)

In response, Applicants note that Berry discloses a method of indexing keywords for searching in a database recorded on a CD-ROM, with the objective of improving the time requirement for accessing data (see, for example, column 1, line 7 to column 2, line 66) . Applicants further note that Berry does not teach or suggest anything about an "electronic mail message" or the desirability of scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message in a manner that advantageously provides enhanced performance and versatility by being able to schedule the event in response to at least two different types of program identification information (e.g., channel/time information and/or a program name), as provided by the claimed invention. As such, Applicants submit that the proposed combination including Berry fails to teach or suggest, *inter alia*, the claimed element of "continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information", as recited by independent claims 10, 17 and 24. Accordingly, Berry not only fails to remedy the deficiencies of the Hirata/Westlake combination, but as will hereinafter be discussed, also constitutes "non-analogous art" under the law of the Federal Circuit, and therefore has no legal bearing on the determination of obviousness under 35 U.S.C. §103 in this case.

The determination of whether a prior art reference is analogous or not is based on a two-step test. In particular, under the two-step test for determining whether a prior art reference is non-analogous and thus not relevant in determining obviousness, it must be determined (1) whether the reference is "within the field of the inventor's endeavor," and (2) if not, whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved." See, for example, In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

With respect to step (1), the Berry reference endeavors to provide a method of indexing keywords for searching in a database recorded on a CD-ROM, with the objective of improving the time requirement for accessing data (see, for example, column 1, line 7 to column 2, line 66). In contrast, the claimed invention endeavors to

provide a method and apparatus for scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message that advantageously provides enhanced performance and versatility by being able to schedule the event in response to at least two different types of program identification information (e.g., channel/time information and/or a program name). Accordingly, Berry is clearly not "within the field of the inventor's endeavor", and therefore fails step (1) of the two-step test.

Next, with respect to step (2), one of ordinary skill in the art would not likely even consider looking at prior art such as Berry related to indexing keywords for searching in a database recorded on a CD-ROM, with the objective of improving the time requirement for accessing data when confronted with the problem of how to provide a method and apparatus capable of scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message that advantageously provides enhanced performance and versatility by being able to schedule the event in response to at least two different types of program identification information (e.g., channel/time information and/or a program name) as claimed. Accordingly, the Berry reference is clearly not "reasonably pertinent to the particular problem with which the inventor was involved" and therefore also fails step (2) of the two-step test.

As explained above, the proposed combination of Hirata, Westlake and Berry fails to teach or suggest all of the elements of independent claims 10, 17 and 24. Moreover, Berry is non-analogous art and is not considered relevant in determining obviousness under 35 U.S.C. §103 in this case. Accordingly, Applicants respectfully request that the rejection of claims 10-29 be withdrawn.

Conclusion

Having fully addressed the Examiner's rejection it is believed that, in view of the foregoing remarks/arguments, this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6813, so that a mutually convenient date

and time for a telephonic interview may be scheduled. No fee is believed due. However, if a fee is due, please charge the fee to Deposit Account 07-0832.

Respectfully submitted,

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